IN THE U. S. PATENT AND TRADEMARK OFFICE

In re application of

Mikko VIIKARI et al.	Conf. 4043
Application No. 10/588,890	Group 2164
Filed: January 5, 2007	Examiner Fazlul QUADER
Title: DATA PROCESSING SYSTEM	

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents   August 26, 2010
P.O. Box 1450
Alexandria, VA   22313-1450

Sir:

      Appellants request a pre-appeal brief review of the final rejection in the above-identified application. No amendments are being filed with this request. A Notice of Appeal is filed herewith. No fee has been included as a fee was paid in connection with the Notice of Appeal previously filed. Should a fee be required, the Commissioner is hereby authorized to charge payment the fee to Deposit Account No. 25-0120.

      The review is requested for the reasons advanced on the attached pages.

                  Respectfully submitted,

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REASONS IN SUPPORT OF REQUEST FOR REVIEW

Applicants acknowledge the interview held with the Examiner and the Examiner's assistance. However, that interview has not resolved the pending rejections. The rejections do not explain why the Examiner believes that claims are obvious and accordingly do not establish *prima facie* obviousness.

A pre-appeal review of claim 33 is requested. The rejection includes legal and factual errors in that the rejection does not identify/explain how the Examiner is reading the claim onto the referenced passages of the applied art sufficiently to establish that claim 33 is *prima facie* obvious.

Claim 33 is rejected as obvious over Sorvari 2004/0043758, in view of Barry 2005/0216421, and further in view of Smith 2003/0083938.

I. Claim 33 recites "a database system for storing data elements".

The rejection asserts that Sorvari paragraph [0050] discloses this feature. There is disclosure of the mobile station receiving data from remote servers; however, there is no disclosure of the data coming from a database storing data elements. Data from the remote servers need not come from a database storing data elements.

If the Examiner is drawing some sort of conclusion from the [0050] disclosure or relying on other knowledge beyond what is disclosed, then that analysis and conclusion should be stated.

2

II. Claim 33 next recites "a data processing system for processing data elements, the data processing system being associated to a first subscriber of a telecommunications system".

The rejection asserts that Sorvari paragraph [0047] discloses this feature. Sorvari paragraph [0047] discloses a mobile telephone which can communicate through a public land mobile network (PLMN).

The Examiner has not explained how this paragraph discloses "a data processing system for processing data elements" or "the data processing system being associated to a first subscriber of a telecommunications system". Because of these omissions, this part of the rejection is legally and factually insufficient. If the Examiner is assuming that the phone comprises "a data processing system for processing data elements", then the Examiner should so state and explain what are the recited "data elements". Otherwise, applicants have no idea what the Examiner is thinking as to what in Sorvari corresponds to the recited "data elements".

III. Claim 33 next recites the data processing system (previously recited) comprising a first database with at least part of its records containing <u>name information given by the first subscriber to one or more other subscribers</u> of the telecommunications system and <u>subscriber addresses of the one or more other subscribers</u> in the telecommunications system.

On page 4, the rejection states that "a first database with at least part of its records containing the name information of a subscriber of a telecommunications system and the subscriber's address in the telecommunications system *[is disclosed by Sorvari paragraph]* ([0048])".

However, see that the recitation is that the first database includes records containing <u>name information given by the first subscriber to one or more other subscribers</u> of the telecommunications system and <u>subscriber addresses of the one or more other subscribers</u> ….

The Examiner has not identified how this is disclosed.

IV. Claim 33 further recites "the database system comprising a server and a second database". The rejection states that paragraphs [0028-0029] disclose "the database system comprising a server and a second database".

The Examiner has not identified how these paragraphs disclose the recited features. The rejection in general points to paragraphs within Sorvari as satisfying various claimed features without explaining how the recitation is being interpreted, what specific portion of the passage is being relied upon, or how any passage satisfies the recitation.

It is insufficient to find prior art or passages within the prior art that is only somehow generally related to the same technology and then assert that specific recitations are disclosed.

V. Claim 33 recites "said output means are arranged to output to the first subscriber at least a part of the content of a data element in connection with at least one selection option for selecting name information of the one or more other subscribers". The rejection states that paragraphs [0035] and [0038] disclose these features.

These paragraphs disclose the exchange of metadata between the mobile phone and server, but not what is recited. There is no identification of how the Examiner is reading the output means (of e.g., a mobile phone) outputting content of a data element <u>in connection with at least **one selection option** for selecting name information</u> of the one or more other subscribers. The Examiner does not explain any selection option being presented to the user.

VI. Claim 33 recites "the data processing system is, in response to the name selection by the first subscriber, arranged to fetch from the first database a subscriber address related to the selected name information; and to attach to the data element person-based metadata that contains the fetched subscriber address;".

The rejection offers paragraph [0048] as disclosing this feature. The Examiner has not explained how this feature is disclosed or made any specific factual findings that point to passages corresponding to the recitation.

VII. Finally, claim 33 recites "the data processing system is arranged to receive a fetch request for a data element from a second subscriber accessing the server; and to check the access right to the data element by comparing the subscriber address attached to the fetch request with the person-based metadata of the data element."

The rejection appears to rely on paragraphs [0028] and [0029] for these features, except for "checking the access right to the data element by comparing the subscriber address attached to the fetch request with the person-based metadata of the data element".

Again, the Examiner has not explained how these paragraphs are disclosing the subject matter being recited.

Applicants respectfully urge that both the statue and MPEP require that the rejection be sufficient clear to demonstrate a factual basis for finding a claim obvious. This rejection (as well as the remaining rejections) does not satisfy this standard.

Accordingly, the rejection of claim 33 is improper. The rejection includes legal and factual errors in that the rejection does not clearly identify/explain how the Examiner is reading the claim onto the referenced passages of the applied art sufficient to establish the claim 33 is *prima facie* obviousness.

Applicants appreciate the review of this claim.